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Applicant(s) Douglas B. Wilson
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Title FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS
AND THE LIKE
Examiner Vinh Luong
Unit 3682

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief – Patents
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SIR:

This is a Reply Brief pursuant to 37 C.F.R. §41.41 in response to the Examiner's Answer dated January 17, 2008.

I. General

This paper is in reply to the Examiner's Answer dated January 17, 2008. In that Answer, the Examiner stated his basis to support his anticipation rejections of the claims on appeal, claims 20-28. Claims 20-26, and 28/20 were rejected for anticipation under 35 U.S.C. §102 based on U.S. Patent No. 2,118,540 to Van Arsdel ("Van Arsdel"), U.S. Patent No. 2,134,020 to Anson ("Anson"), or U.S. Patent No. 1,575,848 to Laubach ("Laubach"). Appellant submits that the legal bases relied on by the Examiner as support for his anticipation rejections are misplaced. Further, the factual explanations the Examiner has advanced to make out the *prima facie* bases for anticipation do the opposite and support Appellant's position that claims 20-28 are patentable over Van Arsdel, Anson, and Laubach.

II. The Case Law Does Not Support The Examiner's Position

A. *In re Schreiber* Is Improperly Relied On

In the Examiner's Answer, the Examiner relied on two cases to support his contention that claims 20-28 were anticipated by Van Arsdel, Anson, and Laubach.

Claim 20 and other claims below are anticipated by Van Arsdel because Van Arsdel teaches each and every positively claimed element. It is well settled that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than functions. MPEP 2114 cited *In re Schreiber*, 128 F.3d 1473, 1477-78, 44, USPQ2d 1429, 1431-32 (Fed. Cir. 1997). In addition, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. Inter. 1987). Cited in MPEP 2114, *supra*. [Emphasis added.] Examiner's Answer, pp. 3-4.

Looking first at *Schreiber*, the facts of this case are inapposite to the present application and such a circumstance has an impact on *Schreiber*'s application in the present appeal. In *Schreiber*, the portion of the claimed invention at issue and the prior art had the same shape and the applicant there sought to distinguish the claimed invention from the prior art by stating that the prior art did not perform in the same manner as the claimed invention. The applicant in *Schreiber* also submitted a declaration stating the same. In this regard, *Schreiber* states:

There is no dispute that the structural limitation recited in *Schreiber*'s application are all found in the Harz [prior art] reference upon which the examiner and the Board relied. Thus, to use the terms found in *Schreiber*'s claim 1, Harz discloses a "dispensing top" that has "a generally conical shape and an opening at each end," and "means at the enlarged end of the top to embrace the open end of the container, the taper of the top being uniform." *Schreiber* argues, however, that Harz does not disclose that such a structure can be used to dispense popcorn from an open-ended popcorn container [rather than oil]. [Emphasis added.]
In re Schreiber, 128 F.3d at 1477.

The Federal Circuit in response to this argument by inventor *Schreiber* stated:

Although *Schreiber* is correct that Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It

is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable [citations omitted]. Accordingly, Schreiber's contention that his structure will be used to dispense popcorn does not have any patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn.

In re Schreiber, 128 F.3d at 1477.

Appellant submits that the Examiner is relying on the quotation immediately above to support his rejection; this is improper for the application on appeal. In *Schreiber*, a comparison of the prior art and the claimed invention showed that they looked the same and the applicant Schreiber was arguing that despite this the prior art structure would not *function* the same as the claimed invention. Appellant is not making such a contention. What Appellant submits and the Examiner fails to recognize is the claims of the present application positively recite structural and functional features that combined clearly distinguish these claims from the prior art. *Schreiber* does address Appellant's specific issue but the Examiner fails to appreciate the Federal Circuit's position on this.

Schreiber specifically addresses the issue of patentability where functional and structural features are involved. However, the Examiner does not cite this portion of *Schreiber*. This is believed because the Examiner cited to the bridging language at pages 1477 and 1478, and the germane portion is found later on page 1478. At this later location on page 1478, the Federal Circuit raises the issue of functional limitations distinguishing claims over the prior art:

Schreiber further argues that the functional limitations of his claim distinguish it from Harz. In particular, Schreiber points to the recitation that the claimed top "allows several kernels of popped popcorn to pass through at the same time," and that the taper of the top is such "as to by itself jam up the popped popcorn before the end of the cone and permit the dispensing of only a few kernels at a shake of a package when the top is mounted on the container."

In re Schreiber, 128 F.3d at 1478.

What the Examiner fails to appreciate with regard to *Schreiber* is the Federal Circuit's explicit treatment of functional limitations for providing a basis for patentability. In this respect, the Federal Circuit states:

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 58 C.C.P.A 1027, 439 F.2D 210, 212, 169 USPQ 226, 228 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 28: where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [Citations omitted.]

In re Schreiber, 128 F.3d at 1478.

The Examiner in his citation to *Schreiber* expressly does not follow the Federal Circuit in its pronouncement that patentability may be established through functional limitations when he stated that “claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than functions” [emphasis added] and cites *Schreiber* as support. As shown above, *Schreiber* does not state this and, in fact, it states the contrary. Therefore, the Examiner has advanced an incorrect interpretation of the case.

When the functional limitations of claims 20-26 and 28/20 were raised as at least one basis for patentability and it was challenged by the Examiner, it became Appellant’s burden to show that the functional limitations were not inherent features to the prior art being relied on. *See In re Schreiber*, 128 F.3d at 1478. Appellant showed that neither Van Arsdel, Anson, nor Laubach provided structural and functional features that would perform deforming of the second section as set forth in the appealed claims. Accordingly, Appellant has met his burden with respect to each of the references relied on by the Examiner by providing very clear grounds why the functional limitations were not inherent features in any of the three references, as will be discussed in detail subsequently. Therefore, following *Schreiber*, the claims on appeal should be found patentable over the three references cited by the Examiner in support of his anticipation rejections.

1. Van Arsdel Does Not Anticipate Claims 20-28

In the Appeal Brief, Appellant pointed out to the Examiner that Van Arsdel differed in at least the following way:

The Examiner's citation to Van Arsdel to support his contention that it teaches each of the elements of the second section is the following:

The rotation of the steering wheel by hand pressure against the flanges 4 and 5 is assisted by the palm and fingers which are wrapped around the rim of the wheel, and to increase the finger hold of the grip-rest 2, which is thickened and bifurcated to straddle the rim as shown in Fig. 6, is provided with recesses separated by ridges here shown as three in number, 6, 7, and 8...

The weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest as shown in Fig. 1, or with the ball of the thumb seated in the concavity as shown in Fig. 2...

My improved grip-rest may be formed integrally with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it removable as an attachment for any make of car and also to make it adjustable to suit the requirements or fancy of the driver.

Van Arsdel, Page 1, Right Column, Lines 29-54.

The Examiner contends that the grip-rest is deformable; however, Appellant submits that this is not supported by Van Arsdel. Van Arsdel requires the following to move the grip-rest: loosen the screw, reposition the grip-rest, and retighten the screw. (Van Arsdel, Page 2, Left Column, Lines 28-32.) Appellant submits that this is not deforming according to claim 20 during use of the grip-rest. Once the grip-rest of Van Arsdel is in place, it is fixed, and does not move. Thus, Van Arsdel is missing at least the deforming element.

Appellant's position on the teachings of Van Arsdel is supported by the reference:

The grip-rest 2 is concave longitudinally and about half of the rest extends over and part way across a steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 of the side, and 5 of the rear end of the concave, located above the rim, extends up into a marginal flange to be contacted by the inside of the ball of the thumb or by the bottom of the hand, depending upon which part of the hand is seated on the rest. These flanges 4 and 5 enable the operator instantly to feel any deviation of the car from a straight course and gives him something substantial to push against in resistance and also in rotating the wheel to steer the car around corners and curves and away from obstructions or bad places in the roadway.

[Emphasis added.]

Van Arsdel, Page 1, Right Column, Lines 13-28.

The quotation immediately above clearly demonstrates that the grip-rest of Van Arsdel does not deform according to claim 20 when pressure is applied to it. Noting this, Van Arsdel is missing at least one element and, as such, it cannot establish a *prima facie* basis of anticipation.

Appeal Brief, p. 8.

The section of the Appeal Brief quoted above demonstrates the clear patentable difference between the present invention and Van Arsdel, and that the Examiner's reliance on the reference to make out a *prima facie* anticipation rejection is improper. Therefore, the Board should reverse the Examiner's rejection based on Van Arsdel and remand it to the Examiner with instructions to withdraw the anticipation rejection based on Van Arsdel.

2. Anson Does Not Anticipate Claims 20-26 and 28/20

With regard to Anson, in the Appeal Brief, Appellant distinguished this reference in the following manner after noting how the Examiner placed tremendous weight on the description of the Attachment (handgrip) in Anson in considering the issue of anticipation:

I [Anson] have found that in the driving of an automobile and particularly when driving for extended periods of time over long distances, the normal manner of holding and manipulating the steering wheel, wherein both driver's hands grasp the wheel and positions which require the driver's arms to remain in a raised and more or less unnatural and uncomfortable position, considerable strain develops in the driver's hands, arms, shoulders and back particularly, and results in excess of fatigue...

To obviate these disadvantages, I have devised an attachment for steering wheel, which permits a driver to assume a completely comfortable and relaxed driving position, while at the same time, affords a means permitting the driver to at all times retain positive operating control of the steering wheel. [Emphasis added.]

Anson, Page 1, Left Column, Lines 6-25.

The steering wheel attachment of Anson is described as follows:

The attachment comprises a hand grip portion 11, which is preferably of bulbular form.... Grip portion 11 normally extends downwardly from the wheel rim and is of suitable length to adapt same to extend to the region of the driver's lap so that it may be grasped by the driver's hand when his hand is resting in a normal comfortable position in his lap. Grip portion 11 is reduced in cross-sectional area at one end to form a neck 12. Neck 12...will have sufficient pliability...to be deflected from its normal pendant position without adversely affecting the measure of control of the steering wheel movements afforded by the positive operating movement of the attachment, while at the same time, neck 12 will retain sufficient rigidity to permit operating movements of hand grip 11 to be positively communicated to the steering wheel rim for effective control of its movements. [Emphasis added.]

Anson, Page 1, Right Column, Line 49 – Page 2, Left Column, Line 18.

The Examiner has cited Anson at Page 2, Left Column, Lines 62-72, as teaching the deformability element of the second section in claim 20. As the quotation above demonstrates, when the Anson handgrip is in use, it is in the pendant position below the steering wheel and used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendant-hanging handgrip would not be deformed as set forth in claim 20 because it would not be in use at all. Moreover, if it were used, it would not be deformed out of interference but would be held in the pendant position to steer the vehicle and not released. Therefore, there is not an inherent feature of the Anson handgrip to deform out of interference as set forth in the claims.

The Examiner has stated the handgrip of Anson equates to deformation according to claim 20 because it may be moved from the bottom pendant position to the top of the steering wheel. When the handgrip is moved to the top, it is moved there to be placed purposefully out of use all the time. As such, it will not be in a position to be deformed as set forth in the second section of claim 20. [Footnote omitted.] If the handgrip is moved to the top of the steering wheel, as suggested by the Examiner, it would be awkward and dangerous to use for driving because the driver's hands would be disposed through the steering wheel. In this position, it also would not provide any of the benefits recited in Anson to relieve fatigue in the arms and hands of the driver when the handgrip is used with the driver's hands in his/her lap. In order to move the handgrip, it would be understood that the vehicle would have to be stopped, the handgrip detached and repositioned at the top, and reattached -- this is not deformation as in the appealed claims.

Appeal Brief pp. 8-10.

Like the hand grip of Van Arsdel, the Examiner has equated the act of detaching the Attachment (handgrip) of Arson and moving it to a new location as the equivalent of functional limitations of the claims on appeal. However, it is plain that the Attachment (handgrip) of Anson does not inherently possess the functional limitations of the claims as set forth with respect to the second section. Noting this, Anson is missing at least the deforming element of claim 20 and, as such, it does not support a *prima facie* basis of anticipation. As such, the Board should reverse its Examiner's rejection based on Anson and remand it to the Examiner with instructions to withdraw the anticipation rejection based on Anson.

3. Laubach Does Not Anticipate Claim 20, 27, and 28/27

In the Appeal Brief, Appellant demonstrated that the invention of claims 20, 27, and 28/27 are distinguishable from Laubach at least because of the functional limitations of the second section of the claimed system.

Laubach states the following with regard to the knobs attached to the steering wheel:

By particularly considering the Figures 2 and 3, it will be seen that these knobs 2 are secured to the rim of the wheel 1 by means of securing screws 4, these screws being threaded as indicated at 5 longitudinally through the knob 2, and extending for quite a distance through the entire length of the knobs, thereby efficiently bracing the same. The inner ends of the knobs 2 are concave as indicated at 6, so as to conform to the contour of the outer periphery of the wheel 1...

Each knob 2 is provided with a plurality of finger sockets 9 upon the upper face thereof, and an enlarged head portion 10 at the outer end thereof, for the purpose of facilitating the gripping of the knob and preventing the accidental slipping of the hand of the operator from the knob 2.

[Emphasis added.]

Laubach, Page 1, Lines 43–71.

The description of the knobs and a review of the Figures make plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new

location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel, as does the second section of claim 20. In fact, once the Laubach knobs are secured by screws 5, as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Moreover, if the driver were to attempt to grab the steering wheel at the locations of the knobs in an emergency, the knobs would not deform and would prevent the driver from grabbing the wheel at these knob locations. Therefore, Laubach does not support a *prima facie* basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs.

Appeal Brief, p. 11

As with Van Arsdel and Anson, the Examiner has equated moving the knobs by detaching them and reattaching them as the deformation of the second section according to the present invention. This is improper. Therefore, Laubach does not make out a *prima facia* basis for anticipation. Noting this, the Board should reverse the Examiner's rejection based on Laubach and remand it to the Examiner with instructions to withdraw the anticipation rejection based on Laubach.

B. *Ex parte Masham* is Misapplied

As previously stated, the Examiner has cited *Ex parte Masham* for the following proposition:

In addition, a claim containing a "*recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus*" if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. Inter. 1987).
Cited in MPEP 2114, *supra*. [Emphasis added.]

Examiner's Answer, p. 3.

The facts of *Masham* are that the claimed and prior art device were the same except that the apparatus of the claimed invention was fully submerged for mixing the developer material and the prior art apparatus was only partially submerged. This is not the issue in the application in this appeal.

The claims in the present Appeal are at least distinguished from Van Arsdel, Anson, and Laubach based on the apparatus of each of these references not being capable of performing the functional limitations of appealed claims. Moreover, the way that the Examiner has contorted the references without any support from the specification to try to show that each performs the functional limitations of the appealed claims is improper. The Examiner in each case states that the actions of removing the handgrip from a fixed location on the steering wheel rim, moving it to another location along the rim, and then reattaching it to the rim equates to the deforming feature according to the claims on appeal. Appellant submits that such actions do not anticipate the appealed claims with regard to the second section deforming. Therefore, the Examiner's reliance on *Masham* is in error. As such, *Masham* has been misapplied and should not be given weight in the present appeal.

III. Conclusion

Appellant has demonstrated that the Examiner's reliance on case law is misplaced and does not support his positions. Appellant also has shown that Examiner has improperly relied on this case law and therefore failed to make out a *prima facie* case for anticipation based on Van Arsdel, Anson, or Laubach. Given this, it is prayed that the Board will remand the anticipation rejections to claims 20-28 under 35 U.S.C. §102 based on Van Arsdel, Anson, or Laubach and direct the Examiner to reverse these rejections and pass the application to issue.

No fees are believed due; however, please charge any additional fees due or overpayments to Deposit Account No. 08-0219.

Respectfully submitted,

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